

88



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,282	01/16/2001	Diane Banks	2000-0301B	1137

7590 03/01/2005

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EXAMINER

BATES, KEVIN T

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,282

Applicant(s)

BANKS ET AL.

Examiner

Kevin Bates

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Office Action is in response to a communication made on November 4, 2004.

Claims 1-43 are pending in this application.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date or dates under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 40, 41, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amendments that have been made to the claims define the invention in terms of what it is not, rather than further defining the invention. See *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-32, 35 and 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Burgan (6459892).

Regarding claims 1, 40, and 41, Burgan discloses a computer-based method for a mobile information device to participate in a chat session (Column 2, lines 14 – 15), comprising the activities of: obtaining information regarding at least one state variable (Column 8, lines 5 – 9); applying a predetermined decision logic to the state variable information (Column 5, lines 22 – 29); identifying a chat trigger from the application of the predetermined decision logic to the state variable information (Column 5, lines 27 – 29; Column 6, lines 14 – 24); identifying a chat group associated with the chat trigger; and seeking connectivity between an information device and the chat group associated with the chat trigger (Column 7, lines 60 – 64).

Regarding claims 2, 3, 4, and 5, Burgan discloses the act of measuring, detecting, receiving, recognizing a change in the state variable information (Column 5, lines 15 – 29; Column 8, lines 5 – 9).

Regarding claims 6 and 7, Burgan discloses determining and programming the decision logic (Column 8, lines 5 – 9; Column 7, lines 60 – 64).

Regarding claims 8, 9, and 10, Burgan discloses receiving and detecting the chat trigger, and associating the chat trigger with the chat group (Column 6, lines 14 – 24).

Regarding claim 11, Burgan discloses identifying the chat group (Column 6, lines 21 – 24).

Regarding claim 12, Burgan discloses offering an identification of the chat group (Column 6, lines 21 – 24).

Regarding claim 13, Burgan discloses offering an identification of available chat groups (Column 7, lines 60 – 64).

Regarding claim 14, Burgan discloses identifying available chat groups (Column 7, lines 60 – 64).

Regarding claim 15, Burgan discloses identifying a subject matter of available chat groups (Column 7, lines 60 – 64).

Regarding claim 16, Burgan discloses filtering available chat groups based on one or more predetermined criteria (Column 7, lines 60 – 64).

Regarding claim 17, Burgan discloses selecting available chat groups based on one or more predetermined criteria (Column 7, lines 60 – 64).

Regarding claim 18, Burgan discloses sorting available chat groups based on one or more predetermined criteria (Column 7, lines 60 – 64).

Regarding claim 19, Burgan discloses grouping available chat groups based on one or more predetermined criteria (Column 7, lines 60 – 64).

Regarding claim 20, Burgan discloses rendering available chat groups based on one or more predetermined criteria (Column 7, lines 60 – 64).

Regarding claim 21, Burgan discloses comprising receiving a chat group identification (Column 7, lines 60 – 64).

Regarding claim 22, Burgan discloses offering the mobile information device an opportunity to initiate a chat group (Column 6, lines 4 – 10).

Regarding claim 23, Burgan discloses recommending connectivity between the mobile information device and the chat group (Column 7, lines 63 – 64).

Regarding claim 24, Burgan discloses requesting connectivity between the mobile information device and the chat group (Column 8, lines 4 – 17).

Regarding claim 25, Burgan discloses obtaining connectivity between the mobile information device and the chat group (Column 8, lines 14 – 17).

Regarding claim 26, Burgan discloses providing connectivity between the mobile information device and the chat group (Column 8, lines 14 – 17).

Regarding claim 27, Burgan discloses identifying an initial chat message to post to the chat group (Column 10, lines 35 – 48).

Regarding claim 28, Burgan discloses exchanging a chat message with the mobile information device (Column 9, line 66 – Column 10, line 2).

Regarding claim 29, Burgan discloses exchanging a chat message between the mobile information device and a chat group associated with the chat trigger (Column 10, lines 10 – 20).

Regarding claim 30, Burgan discloses providing a chat message to the mobile information device (Column 10, line 49 – 64).

Regarding claim 31, Burgan discloses providing a chat message from the mobile information device (Column 10, lines 10 – 20).

Regarding claim 32, Burgan discloses providing a modality translation of a chat message to the mobile information device (Column 10, lines 2 – 9).

Regarding claim 35, Burgan discloses providing a message from the mobile information device to the chat group (Column 10, lines 10 – 20).

Regarding claim 39, Burgan discloses terminating connectivity upon a change in the state variable information (Column 13, lines 59 – 64).

Regarding claim 42, Burgan discloses a method for an information device to participate in a chat session, comprising the activities of: detecting a chat trigger (Column 5, lines 27 – 29; Column 6, lines 14 – 24); and offering to a mobile information device an identification of chat groups associated with the chat trigger seeking connectivity between the mobile information device and an identified chat group (Column 7, lines 60 – 64).

Regarding claim 43, Burgan discloses a method for an information device to participate in a chat session, comprising the activities of: detecting a chat trigger (Column 5, lines 27 – 29; Column 6, lines 14 – 24), and identifying at least one information device associated with the chat trigger; and seeking connectivity between at least one information device and a chat session (Column 7, lines 60 – 64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-34 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgan in view of Bogard (6757365).

Regarding claims 33-34 and 36-38, Burgan does not explicitly indicate translating a chat message from text to speech. Bogard teaches in a chat application usable on wireless devices (Column 6, lines 39 – 44), the use of a voice portal to allow text to speech conversation (Column 8, lines 49 – 50; Column 9, lines 38 – 49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow chat features to be able to occur on multiple platforms, more notably platforms which cannot receive text messages (Column 8, lines 45 – 51).

Response to Arguments

Applicant's arguments filed November 4, 2004 have been fully considered but they are not persuasive.

Regarding the arguments to claims 1, 40, 41, 42, and 43, the applicant argues that the reference, Burgan, does not disclose a state variable that is not indicative of a chat server status, chat group status, or chat message. The examiner disagrees, as seen in the 35 U.S.C. 112, second paragraph rejection, those limitations fail to further limit the scope of the claims because they define the invention in terms of what it is not, rather than further defining the invention, thus cannot be considered a limitation of the

claims. Since the reference Burgan discloses at least a state variable that acts in accordance to the other limitations it meets the limitations of the claims and establishes a prima facie case of anticipation.

Regarding the arguments to claims 33-34 and 36 – 38, the applicant argues that the reference Bogard is not a properly available reference based on the priority date of the co-pending applications, that the reference Bogard does not overcome the deficiencies of Burgan, and that there is no motivation to combine the references. The examiner disagrees, as seen in the Priority section of this Office Action, this document does not receive the priority date of the co-pending applications under 35 U.S.C. 120 since the specification includes new matter that were not included in the specifications of the co-pending U. S. applications 09/666,564 and 09/666565 and which that new matter is also included within claims 33-34 and 36-38. Regarding the fact Bogard does not overcome the deficiencies of Burgan and that there is no motivation to combine, as seen in the 35 U.S.C. 103(a) rejection, Burgan's deficiencies of the claim only includes a text to speech portal, which Bogard clearly teaches in (Column 8, lines 49 – 50; Column 9, lines 38 – 49), where the motivation would be the added features and usability of having the messaging programs work on systems that can only receive voice messages, to function and receive those voice messages in Burgan's system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (571) 272-3980. The examiner can normally be reached on 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/759,282

Page 10

Art Unit: 2155

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February 17, 2005

Bharat Barot

**BHARAT BAROT
PRIMARY EXAMINER**